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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,718	11/28/2000	Larry Gold	NEX 10-6	1084

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EXAMINER

ZITOMER, STEPHANIE W

ART UNIT PAPER NUMBER

1634

DATE MAILED: 06/13/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,718

Applicant(s)

GOLD ET AL.

Examiner

Stephanie Zitomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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DETAILED ACTION

Application status

1. Receipt of the amendment filed September 5, 2001 is acknowledged.
2. Rejections not reiterated herein from the previous Office action, paper no. 5, mailed June 6, 2001, have been withdrawn in view of the amendments to the claims and applicant's arguments.
3. The obviousness-type double patenting rejections set forth in paper no. 5 are maintained. Applicant's stated agreement to submit a terminal disclaimer in regard to the patents cited in the rejections is noted.

Double patenting obviousness type rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 5,705,337. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claim is drawn to a method in which nucleic acid ligands that bind covalently with a target molecule are identified wherein the candidate mixture nucleic acids in the method comprise photoreactive groups. It would have been obvious to the skilled practitioner in the art to provide the nucleic acid ligand identified by the recited method wherein such nucleic acid ligand comprises a photoreactive group which was known in the

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art to be able to crosslink a target molecule and where photoreactive groups including 5-bromouracil and 5-iodouracil were known in the art. The skilled practitioner in the art would have been motivated by the known utility of nucleic acids in detection and purification of target molecules among other known benefits.

5. Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 15 of U.S. Patent No. 6,001,577. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are drawn to a method in which nucleic acid ligands that bind covalently with a target molecule are identified wherein the candidate mixture nucleic acids in the method comprise photoreactive groups. It would have been obvious to the skilled practitioner in the art to provide the nucleic acid ligand identified by the recited method wherein such nucleic acid ligand comprises a photoreactive group which was known in the art to be able to crosslink a target molecule and wherein photoreactive groups including 5-bromouracil and 5-iodouracil were known in the art. The skilled practitioner in the art would have been motivated by the known utility of nucleic acids in detection and purification of target molecules among other known benefits.

6. Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 5,998,142. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claim is drawn to a nucleic acid ligand which binds covalently with a protein (target molecule) wherein the nucleic acid ligand comprises a chemically reactive functional unit defined in the patent as including photoreactive groups (column 10, lines 25-27) which include 5-iodouracil (column 29, Example 4).

7. Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 5,962,219. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claim is drawn to a method in which nucleic acid ligands that bind covalently with a target molecule are identified wherein the candidate mixture nucleic acids in the method comprise photoreactive groups. It would have been obvious to the skilled practitioner in the art to provide the nucleic acid ligand identified by the recited method

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wherein such nucleic acid ligand comprises a photoreactive group which was known in the art to be able to crosslink a target molecule and where photoreactive groups including 5-bromouracil and 5-iodouracil were known in the art. The skilled practitioner in the art would have been motivated by the known utility of nucleic acids in detection and purification of target molecules among other known benefits.

8. Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15 and 16 of U.S. Patent No. 5,763,177. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are drawn to a nucleic acid ligand that photocrosslinks to a protein (target molecule) identified by a SELEX method wherein the candidate mixture nucleic acids comprise a photoreactive group selected from a group comprising the photoreactive groups recited in claim 12.

Conclusion

10. **No claim is allowed.** However, the claims are free of the prior art and may be placed in condition for allowance by submission of an appropriate Terminal Disclaimer.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie Zitomer whose telephone number is (703) 308-3985. The examiner can normally be reached on Monday through Friday from 9:00 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152. The official fax phone number for this Group is (703) 308-4242. The unofficial fax number is (703) 308-8724. The examiner's Rightfax number is 703-746-3148.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196. For questions and requests relating to formal matters contact Patent Analyst Tiffany Tabb at 703-605-1238.



Stephanie Zitomer, Ph.D.

June 4, 2002